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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/518,644	12/20/2004	Shojiro Komatsu	043058	2836
38834 7590 08/07/2007 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW			EXAMINER	
			LANGEL, WAYNE A	
SUITE 700 WASHINGTON, DC 20036		ART UNIT	PAPER NUMBER	
WASHINGIO	71, 50 20030		1754	
			MAIL DATE	DELIVERY MODE
			08/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	· · · · · · · · · · · · · · · · · · ·	Application No.	Applicant(s)			
Office Action Summary		10/518,644	KOMATSU ET AL.			
		Examiner	Art Unit			
		Wayne Langel	1754			
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply						
A SH WHIC - Exte after - If NC - Failu Any	ORTENED STATUTORY PERIOD FOR REPLY CHEVER IS LONGER, FROM THE MAILING DANS nations of time may be available under the provisions of 37 CFR 1.13 SIX (6) MONTHS from the mailing date of this communication. Operiod for reply is specified above, the maximum statutory period were to reply within the set or extended period for reply will, by statute, reply received by the Office later than three months after the mailing ed patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tir vill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	N. nely filed the mailing date of this communication. (O (35 U.S.C. § 133).			
Status						
2a) <u></u> ☐	Responsive to communication(s) filed on This action is FINAL . 2b) This Since this application is in condition for allowar closed in accordance with the practice under E	action is non-final. nce except for formal matters, pro				
Disposit	ion of Claims					
5)□ 6)⊠ 7)□	Claim(s) 1-12 is/are pending in the application. 4a) Of the above claim(s) is/are withdraw Claim(s) is/are allowed. Claim(s) 1-12 is/are rejected. Claim(s) is/are objected to. Claim(s) are subject to restriction and/or	vn from consideration.				
Applicati	ion Papers					
10)	The specification is objected to by the Examine The drawing(s) filed on is/are: a) access Applicant may not request that any objection to the Replacement drawing sheet(s) including the correction The oath or declaration is objected to by the Example 1.	epted or b) objected to by the drawing(s) be held in abeyance. Selion is required if the drawing(s) is ob	e 37 CFR 1.85(a). jected to. See 37 CFR 1.121(d).			
Priority (under 35 U.S.C. § 119		÷			
a)	Acknowledgment is made of a claim for foreign All b) Some * c) None of: Certified copies of the priority documents Certified copies of the priority documents Copies of the certified copies of the priority documents application from the International Bureau See the attached detailed Office action for a list of	s have been received. s have been received in Applicati ity documents have been receive ı (PCT Rule 17.2(a)).	ion No ed in this National Stage			
2) Notice 3) Information	it(s) te of References Cited (PTO-892) te of Draftsperson's Patent Drawing Review (PTO-948) te of Disclosure Statement(s) (PTO/SB/08) te No(s)/Mail Date 12-20-04.	4) Interview Summary Paper No(s)/Mail D 5) Notice of Informal F 6) Other:	ate			

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Allred et al or JP 10-7409 or the article by Komatsu et al. No distinction is seen between the BN and methods disclosed by Allred et al or JP 10-7409 or the article by Komatsu et al (Journal of Physical Chemistry), and that recited in applicants' claims. Regarding Allred et al, The BN would inherently have the properties as recited in applicants' claims, since the BN is prepared by substantially the same method as recited in applicants' claims. (See col. 4, line 26 to col. 6, line 9 of Allred et al; the English Abstract of JP 10-7409; and the entire document for the Komatsu et al article.)

Claims 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 9-12 provide for the use of BN, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it

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merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 9-12 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Komatsu et al '533 and Doll et al are made of record for disclosing methods for forming BN.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Langel whose telephone number is 571-272-1353. The examiner can normally be reached on Monday through Friday, 8 am - 3:30 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Wayne Langel

Primary Examiner

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